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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,187	02/05/2004	Joe A. Wright	4688 (OSI0054/US/8)	7196
7590	01/27/2006		EXAMINER CHEN, VIVIAN	
David G. Burleson OMNOVA Solutions Inc. 175 Ghent Road Fairlawn, OH 44333-3300			ART UNIT 1773	PAPER NUMBER
DATE MAILED: 01/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,187

Applicant(s)

WRIGHT ET AL.

Examiner

Vivian Chen

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/26/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/091,754, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

Therefore, for the purposes of this Office Action:

Claims 1-7, 12-22 are deemed to have a filing date of 02/05/2004.

Claims 8-11 are deemed to have an effective filing date of 03/05/1998.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Due to the number of related patents and copending Applications, the double patenting rejections are presented in abbreviated form.

3. Claims 1-22 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

(a) claims 1-43 of U.S. Patent No. 6,686,051; or

(b) claims 1-88 of U.S. Patent No. 6,660,828; or

(c) claims 1-32 of U.S. Patent No. 6,383,651; or

(d) claims 1-32 of U.S. Patent No. 6,423,418,

The above Patents claim curable or cured coatings derived from compositions comprising an amino resin (e.g., alkyl-etherified melamine formaldehyde resin) and a polymer comprising polyester segments and fluorinated polyether segments, wherein the polyether segments are derived from oxetane with pendant fluorinated groups linked to the polyether segments via an ether linkage, substrates coated with said coatings, and/or methods of forming such coated substrates.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the coatings claimed in the above Patents to conventional substrates such as metals, plastics, polyvinyl chloride, etc. (claim 18-19) in order to form useful articles with stain resistant surfaces such as dry erase surfaces or wall coverings (claims 20-21). One of ordinary skill in the art would have adjusted the curing conditions of the coating (claim 22) depending on the specific curing characteristics of a given coating formulation and the thermal stability or resistance of the substrate to be coated. It would have been obvious to utilize known melamine-based curing resins (claims 6-7) in the above coating compositions depending on the specific curing characteristics required for specific applications and substrates; and the physical properties desired in the resultant end product.

4. Claims 1-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

(a) claims 1-25 of copending Application No. 10/492,472 (US 2004/0219378); or

(b) claims 44-60 of copending Applications No. 10/966,528 (US 2005/0048213).

The copending Applications claim curable or cured coatings derived from compositions comprising an amino resin (e.g., alkyl-etherified melamine formaldehyde resin) and a polymer comprising polyester segments and fluorinated polyether segments, wherein the polyether segments are derived from oxetane with pendant fluorinated groups linked to the polyether segments via an ether linkage, substrates coated with said coatings, and/or methods of forming such coated substrates.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the coatings claimed in the copending Applications to conventional substrates such as metals, plastics, polyvinyl chloride, etc. (claim 18-19) in order to form useful articles with stain resistant surfaces such as dry erase surfaces or wall coverings (claims 20-21). One of ordinary skill in the art would have adjusted the curing conditions of the coating (claim 22) depending on the specific curing characteristics of a given coating formulation and the thermal stability or resistance of the substrate to be coated. It would have been obvious to utilize known melamine-based curing resins (claims 6-7) in the above coating compositions depending on the specific curing characteristics required for specific applications and substrates; and the physical properties desired in the resultant end product.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7, 12-22 are rejected under 35 U.S.C. 102(b) as being anticipated by:

(a) WEINERT ET AL (US 6,383,651); or

(b) CALLICOTT ET AL (US 6,423,418); or

(c) WO 99/450079 (WO '079).

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The above references each disclose curable or cured coatings derived from compositions comprising an amino resin (e.g., alkyl-etherified melamine formaldehyde resin) and a polymer comprising polyester segments and fluorinated polyether segments, wherein the polyether segments are derived from oxetane with pendant fluorinated groups linked to the polyether segments via an ether linkage, substrates coated with said coatings, and methods of forming such coated substrates, wherein the substrate is polyvinyl chloride, the coated substrates are dry erase materials and/or wall coverings, and wherein curing takes place at 150 F or more. (WO '079, see entire document) (CALLICOTT ET AL, see entire document) (WEINERT ET AL '651, see entire document, for example columns 2-7).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-7, 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

(a) WEINERT ET AL (US 6,383,651); or

(b) CALLICOTT ET AL (US 6,423,418); or

(c) WO 99/450079 (WO '079).

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Claims 1-7, 12-22 are rejected under 35 U.S.C. § 102(b) as being anticipated by WEINERT ET AL '651 or CALLICOTT ET AL '418 or WO '079 as stated above. However, in the event the claims are not anticipated, the claims are obvious for the following reasons:

The above references each disclose curable or cured coatings derived from compositions comprising an amino resin (e.g., alkyl-etherified melamine formaldehyde resin) and a polymer comprising polyester segments and fluorinated polyether segments, wherein the polyether segments are derived from oxetane with pendant fluorinated groups linked to the polyether segments via an ether linkage, substrates coated with said coatings, and methods of forming such coated substrates, wherein the substrate is polyvinyl chloride, the coated substrates are dry erase materials and/or wall coverings, and wherein curing takes place at 150 F or more. (WO '079, see entire document) (CALLICOTT ET AL, see entire document) (WEINERT ET AL '651, see entire document, for example columns 2-7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the coatings disclosed in the above references to conventional substrates such as metals, plastics, polyvinyl chloride, etc. in order to form useful articles with stain resistant surfaces such as dry erase surfaces or wall coverings (claims 20-21). One of ordinary skill in the art would have adjusted the curing conditions of the coating (claim 22) depending on the specific curing characteristics of a given coating formulation and the thermal stability or resistance of the substrate to be coated.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 23, 2005


Vivian Chen
Primary Examiner
Art Unit 1773